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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte THOMAS W. DAVISON, TIMOTHY E. TAYLOR,
and ADAM SHER

Appeal 2009-014784
Application 10/713,820
Technology Center 3700

Before CAROL A. SPIEGEL, DONALD E. ADAMS, and
JEFFREY N. FREDMAN, *Administrative Patent Judges*.

FREDMAN, *Administrative Patent Judge*.

DECISION ON APPEAL¹

This is an appeal under 35 U.S.C. § 134 involving claims to an apparatus for providing access to a spinal location within a patient. The Examiner rejected the claims as anticipated. We have jurisdiction under 35 U.S.C. § 6(b). We reverse.

¹ The two-month time period for filing an appeal or commencing a civil action, as recited in 37 C.F.R. § 1.304, or for filing a request for rehearing, as recited in 37 C.F.R. § 41.52, begins to run from the “MAIL DATE” (paper delivery mode) or the “NOTIFICATION DATE” (electronic delivery mode) shown on the PTOL-90A cover letter attached to this decision.

Statement of the Case

The Specification teaches that the “present invention is a cannula for receiving surgical instruments for performing a surgical procedure on a body. The cannula comprises a tube structure defining a passage through which the surgical instruments are inserted into the body” (Spec. 1 ¶ 0005). According to the Specification, the “tube structure includes an expandable portion for enabling an increase in the cross-sectional area of the passage at least at the distal end” (*id.*).

The Claims

Claims 44, 45, and 47-57 are on appeal.² We select claim 44 as representative and claim 44 reads as follows:

44. An apparatus for providing access to a spinal location within a patient, comprising:
- an elongate body having a proximal end and a distal end and defining a length between the proximal and distal ends such that the proximal end can be positioned outside the patient and the distal end can be positioned inside the patient adjacent the spinal location, said elongate body having an outer surface and an inner surface, said elongate body being expandable from a contracted configuration to an expanded configuration, wherein the cross-sectional area of said body at a first location is greater than the cross-sectional area of said body at a second location in the expanded configuration, wherein the first location is distal to the second location; and
 - an arcuate guide having an elongate length, a first end and a second end along which a portion of the elongate body is moveable from its contracted condition

² The Examiner has indicated claim 46 is objected to, but would be allowable if written in independent form (*see* Ans. 4).

to its expanded condition, the arcuate guide extending generally in the direction of expansion between the contracted and expanded conditions.

The issue

The Examiner rejected claims 44, 45, and 47-57 under 35 U.S.C. § 102(b) as anticipated by Murdock³ (Ans. 3-4).

The Examiner finds that

Murdock discloses in figure 1, a device for providing access to a surgical location within a patient, including: an elongate body has a proximal end 12, a distal end 13 and defines a length between the proximal and distal ends such that the proximal end can be positioned outside the patient and the distal end can be positioned inside the patient adjacent the body cavity, and where an arcuate guide 40 (element 40 is known as a cam ring) which is inherently having an elongate length along a portion of the elongated body that is able to move from its contracted condition to its expanded condition

(Ans. 3). The Examiner finds that “Murdock discloses in fig. 5, a surgical device for providing access within a patient body, including a guiding mechanism (the examiner interprets a guiding mechanism which is the same as the arcuate guide 40) comprising a curved elongated portion at 41” (*id.*).

Appellants contend that “the Examiner asserts the cam ring 40 of Murdock is equivalent to the arcuate guide recited in the claims” (App. Br. 6). Appellants contend that the “cam ring 40 of Murdock, however, does not appear to have an elongate length, a first end and a second end along which a portion of the elongate body is moveable, and to be extending generally in

³ Murdock, C.L., US 3,044,461, issued Jul. 17, 1962.

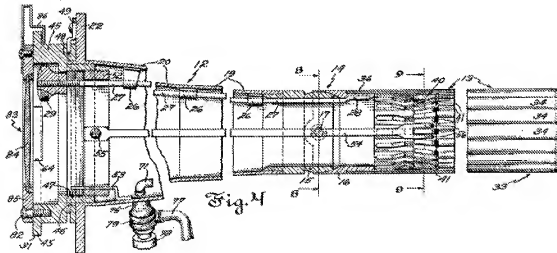
the direction of expansion between the contracted and expanded conditions” (App. Br. 6).

Appellants contend that “no matter how the cam ring 40 of Murdock is interpreted with regard to its movement along a portion of the elongate body (clips 41), the cam ring 40 and clips 41 of Murdock cannot be seen to be equivalent to the structure recited in independent claim 44” (*id.* at 8).

The issue with respect to this rejection is: Does the evidence of record support the Examiner’s conclusion that Murdock anticipates claims 44 and 50?

Findings of Fact

1. Figure 4 of Murdock is reproduced below:



“FIG. 4 is a view . . . showing the unbent instrument shortened in sections of its length” (Murdock, col. 2, ll. 13-16).

2. Murdock teaches that a “proctosigmoidoscope is comprised of two portions or units . . . portion 12 of the length of the hollow structure of the instrument that extends to the exterior of a body cavity into which the instrument is to be inserted is termed the proximal portion . . . The

remaining portion 13, intended to occupy the body cavity when in use, is termed the distal portion” (Murdock, col. 2, ll. 51-62).

3. Murdock teaches that the “composite tubular wall in the distal portion of the instrument . . . can undergo conical expansion of its girth evenly from the pivotal joint 14 to the distal end of the instrument” (Murdock, col. 4, ll. 10-13).

4. Murdock teaches that when “forced toward the hinge joint, ring 40 performs a camming action against the clips 41 that causes simultaneous flexure of the blades radially outward to expand the girth of distal portion 13” (Murdock, col. 4, ll. 36-39).

5. Murdock teaches that when “forced toward the distal end of the instrument, ring 40 will perform a camming action that causes simultaneous flexure of each blade inward thus contracting or restoring the girth of distal portion 13 to its original cylindrical shape” (Murdock, col. 4, ll. 40-44).

6. The word “arcuate” is defined as “curved like a bow.”⁴

Principles of Law

“It is axiomatic that, in proceedings before the PTO, claims in an application are to be given their broadest reasonable interpretation consistent with the specification.” *In re Sneed*, 710 F.2d 1544, 1548 (Fed. Cir. 1983).

“A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.” *Verdegaal Bros., Inc. v. Union Oil Co. of California*, 814 F.2d 628, 631 (Fed. Cir. 1987).

⁴ See <http://www.merriam-webster.com/dictionary/arcuate?show=0&t=1290460573>

Analysis

The Examiner finds that “the elongate length would be the whole segment from the left to the right dimension of element 40. The first and second ends would locate from the left and right edges in the above figures, 4-5.” (Ans. 4). The Examiner concludes that “[t]hus, element 40 does have an elongate length with the first and the second end along which a portion of the elongate body that is moveable from its contracted condition to its expanded condition” (*id.*).

Appellants reply that in “the Appeal Brief, section VII(A)(ii), Appellants presented two possible interpretations of Murdock, each lacking an element recited in claim 44. The Examiner has, for the first time, described how Murdock is being interpreted, which corresponds with the second possible interpretation” (Reply Br. 2). Appellants acknowledge that “the cam ring 40 does appear to have a length (A) and first and second ends (x, z) along which a portion of the elongate body (clips 41) is moveable from its contracted condition (FIG. 4) to its expanded condition (FIG. 5)” (*id.* at 3). Appellants contend, however, that “the width (A) of the cam ring 40 extends longitudinally, while the direction of expansion between the contracted and expanded conditions is transverse (E)” (*id.*). Appellants contend that the “cam ring 40 of Murdock thus cannot be seen to anticipate the claimed ‘arcuate guide extending generally in the direction of expansion between the contracted and expanded conditions’, as recited in claim 44” (*id.*).

We find that Appellants have the better position. We agree that when the limitations of claim 44 are compared to the Examiner’s interpretation of

Murdock, the cam 40 does not “extend generally in the direction of expansion between the contracted and expanded conditions” as required by claim 44.

We also agree with Appellants regarding claim 50 that “clips 41 of Murdock do not extend in a transverse direction, but rather extend in a longitudinal direction as shown in FIG. 5” (Reply Br. 4). Consequently, the clips 41 do not satisfy the requirement of claim 50 for a “curved elongate portion extending in a generally transverse direction.” In other words, Murdock does not disclose an “arcuate guide” as required by the claimed invention.

Conclusion of Law

The evidence of record does not support the Examiner’s conclusion that Murdock anticipates claims 44 and 50.

SUMMARY

In summary, we reverse the rejection of claims 44, 45, and 47-57 under 35 U.S.C. § 102(b) as anticipated by Murdock.

REVERSED

cdc

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